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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,622	09/08/2000	Mary McKenney	10003-025	3096

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EXAMINER

BACKER, FIRMIN

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/657,622

Examiner

Firmin Backer

Applicant(s)

MCKENNEY ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This is in response to a letter for patent filed on September 8th, 2000 in which claims 1-19 are presented for examination. Claims 1-19 are pending in the letter.

Specification

1. The disclosure is objected to because of the following informalities: on page 6, 7, 9, 10, 11 applicant is required to provide the serial number of the U.S. copending application (s) disclosed.

Appropriate correction is required.

Claim Objections

2. Claims 1, 18 and 19 objected to because of the following informalities: Applicant disclosed "its private key." Applicant advised to replace the expression "its" with "a" in order to overcome Examiner's objection.

3. Claim 10 is objected to because of the following informalities: Applicant disclosed "the first customer." Applicant advised to replace the expression "the" with "a" in order to overcome Examiner's objection.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 10-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Linehan (U.S. Patent No. 6,327,578).

6. As per claim 10, Linehan teaches a method of providing payment services (*method, system and program for doing business in an electronic commerce*) (*see fig 1, column 5 line 50, 51*), the method comprising providing a buyer (*consumer 102, 202*) with a plurality of payment instruments (*plurality or party*), each payment instrument having associated therewith a payment instruction (*payment message*) (*see fig 1, column 5 line 61-6 line 8*), the buyer choosing one of the payment instruments (*credit/debit card*) (*see column 9 lines 47-58*), the buyer completing at least a first portion of the payment instruction message associated with the payment instrument chosen by the buyer (*see fig 1, column 5 line 61-6 line 8*), the payment instruction (*authorization token, 254*) message specifying a payment date (*see column 6 line 28-42*), the first customer (*issuing bank, 212*) signing (*digitally signed*) the payment instruction message with a private key corresponding to a digital certificate of the buyer (*see column 6 line 28-42*), the signed payment

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instrument being received by a bank (*issuing bank*), the bank executing the payment instruction on the payment date (*see fig 1, column 3 lines 28-35*).

7. As per claim 11-17, Linehan teaches a method wherein the selected payment instrument is a payment order, payment obligation, conditional payment order, conditional payment obligation, certified payment obligation, certified conditional payment obligation and is negotiable (*see figs, 1, 2A, 2B, 4, 5, column 3 lines 15-47, 5 lines 50-6 lines 48*).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-9, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan (U.S. Patent No. 6,327,578) in view of Park et al (U.S. Patent No. 6,039,248)

10. As per claims 1, 18 and 19, Linehan teaches a method of providing payment services (*method, system and program for doing business in an electronic commerce*) in a four-corner model (*four party protocol*) (*see fig 1, column 5 line 50, 51*) comprising a plurality of entities (*plurality or party*) including a root entity (*acquire gateway 106, 206, 214*) a first participant (*issuing bank, 112, 212*) a second participant (*acquiring bank, 108, 208*), a first customer

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(*consumer 102, 202*), and a second customer (*merchant, 104, 204*), the first customer being a customer of the first participant, the second customer being a customer of the second participant, each entity being provided with a digital certificate (*digital certificates*) (*see figs, 1, 2A, 2B, 4, 5, column 3 lines 15-47, 5 lines 50-6 lines 48*) comprising, the first customer (*consumer, 102*) completing (*fill in*) a buyer's portion of a payment instruction specifying a payment date (*authorization token, 254*) (*see column 6 line 28-42*), the first customer (*consumer, 102*) transmitting (*forward*) the payment instruction (*authorization token, 254*) to the second customer (*merchant*) the second customer completing (*complete the sales transaction*) a seller's portion of the payment instruction (*see fig 2, column 6 lines 48-55*) the second customer (*merchant, 204*) transmitting (*sends*) the payment instruction (*captured request message*) to the second participant (*acquirer bank, 208*) the second participant (*acquirer bank, 208*) completing a second participant portion of the payment instruction (*see fig 1, column 3 lines 28-35*), the second participant signing the payment instruction with its private key (*see fig 1, column 3 lines 28-35*), the second participant transmitting the payment instruction to the first participant (*see fig 1, 2, column 6 lines 54-60*), the first participant executing the payment instruction on the payment date (*see fig 2, column 6 lines 58-62*). Linehan fail to teach an inventive concept wherein the first customer signing the payment instruction with its private key, the second customer signing the payment instruction with its private key. However, Park et al teach an inventive concept wherein the first customer signing the payment instruction with its private key, the second customer signing the payment instruction with its private key (*see fig 3 column 6 lines 25-39*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Linehan's inventive concept to include Park et al's inventive concept wherein the first

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customer signing the payment instruction with its private key, the second customer signing the payment instruction with its private key because this would have provided a system and method to proving the safe realization of the transaction between a consumer and a merchant and prevent a forgery of the document.

11. As per claims 2-7, Linehan teaches a method wherein the payment instruction is a payment order, payment obligation, conditional payment order, conditional payment obligation, certified payment obligation, certified conditional payment obligation and is negotiable (*see figs, 1, 2A, 2B, 4, 5, column 3 lines 15-47, 5 lines 50-6 lines 48*).

12. As per claim 8, Linehan teaches a method wherein the first customer executes a contract with the first participant defining roles and responsibilities in connection with payment services (*see fig 1, column 3 lines 28-35*).

13. As per claim 9, Linehan teaches a method wherein the second customer executes a contract with the second participant defining roles and responsibilities in connection with payment services (*see fig 1, column 3 lines 28-35*).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- a. *Herman et al (U.S. Patent No. 6,341,353) teach a system creates smart receipts that allow merchants and manufacturers to include value added services to the smart receipts. In addition, the invention provides a system that allows the smart receipts to be dynamically updated with new information from merchants and manufacturers.*

- b. *Powar (U.S. Patent No. 6,285,991) teaches a secure interactive electronic account statement delivery system suitable for use over open networks such as the Internet. The present invention utilizes a certification hierarchy to insure that electronic bills, invoices, and other account statements can be sent over open networks with certainty that they will only be received by the intended recipients. The participants in the system are a certification authority, certificated banks, billers and other service providers, and customers. The certification authority grants digital certificates to the certificated banks, which in turn are authorized to grant digital certificates to billers and customers.*

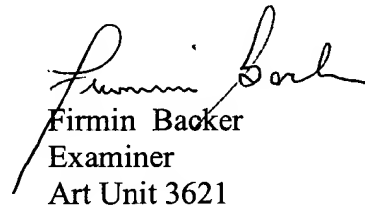
- c. *Fulton et al. (U.S. Patent No. 6,182,052) teach a programmable user interface adapted to provide a multiplicity of images on a touch screen terminal to enable a user to elect from multiple service functions, such as from a group that includes banking, bill paying, shopping, travel, gifts and information.*

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Firmin Backer
Examiner
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February 23, 2003